<u>REMARKS</u>

The present application was filed on November 3, 2000 with claims 1-10. Claims 1-10 are currently pending in the application. Claims 1, 2, 3 and 7 are the independent claims.

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,671,700 (hereinafter "Creemer") in view of U.S. Patent No. 6,633,924 (hereinafter "Wu").

In this response, Applicant traverses the §103(a) rejection, and files a Notice of Appeal.

Applicant respectfully requests reconsideration of the present application in view of the following remarks.

The Manual of Patent Examining Procedure (MPEP), Eight Edition, August 2001, §706.02(j), states as follows with regard to the burden that the Examiner must meet in order to establish a proper §103(a) rejection:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. <u>In re Vaeck</u> 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the Examiner has failed to meet one or more of the above-noted basic criteria, and a proper *prima facie* case of obviousness has therefore not been established. More specifically, Applicant submits that the Creemer and Wu references, even if assumed to be combinable, fail to "teach or suggest all the claim limitations." Further, Applicant submits that there is insufficient motivation to combine Creemer and Wu, or to modify their collective teachings to meet the claim limitations.

Each of the independent claims 1, 2, 3 and 7 recites at least a computer application data file, a computer application send file and a computer application read file. The Examiner argues that

such an arrangement of files is shown in the combined teachings of Creemer and Wu. Applicant respectfully disagrees.

In Creemer, information is shared between a host computer system and a peripheral computer system. More specifically, "a plurality of conduit programs running simultaneously on the host computer system synchronize information between the two computer systems" (Creemer, column 2, line 65, to column 3, line 2). The conduit programs "initiate time multiplex transfers" across "a single communication link between the two computer systems" (Creemer, column 3, lines 2-8). One skilled in the art would immediately recognize that this type of conduit program based time multiplex information transfer is entirely distinct from the claimed arrangements involving application programs reading from or writing to at least a computer application data file, a computer application send file and a computer application read file. In formulating the §103(a) rejection, the Examiner acknowledges the deficiencies of Creemer by attempting to apply a combination of Creemer and Wu to the claims.

However, the Wu reference fails to supplement the deficiencies of Creemer in this regard. Wu, like Creemer, fails to teach or suggest application programs reading from or writing to at least a computer application data file, a computer application send file and a computer application read file, as recited in the claims. Instead, Wu teaches an arrangement involving the use of a synchronization manager that interacts with interface components associated with respective application programs. See Wu at, for example, column 1, line 58, to column 2, line 43. There is no teaching or suggestion in Wu regarding reading from or writing to a computer application send file and a computer application read file as claimed. Wu not only fails to teach or suggest this type of file structure, it actively teaches away from it by teaching to use a synchronization manager in conjunction with interface components associated with respective applications.

Accordingly, it is believed that the collective teachings of Creemer and Wu fail to meet the limitations of the claims.

It should be noted in this regard that the Examiner in formulating the §103(a) rejection has not identified which files in Creemer or Wu are alleged to correspond to the recited computer application send file and computer application read file. The Examiner instead identifies computer application data files, and argues that reading and writing occurs. Applicants, however, are not attempting to claim reading from and writing to application data files. Instead, the claims set forth

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particular types of files, namely, a computer application send file and a computer application read file, which receive notifications as recited. It is these particular files, and their associated notifications, that are not disclosed or suggested by the proposed combination of Creemer and Wu.

Applicant further submits that the Creemer and Wu references are not combinable in the manner urged by the Examiner.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

In the Office Action at page 4, second paragraph, the Examiner argues that one skilled in the art would be motivated to combine Creemer and Wu because "Creemer indicates the flow charts [sic] of how system determine [sic] the communication established between two computer systems." Applicant submits that this statement, and the remaining portion of the second paragraph on page 4 of the Office Action, fail to provide sufficient objective evidence of motivation to combine Creemer and Wu. For example, the Examiner fails to address how one skilled in the art would be motivated to combine two entirely different synchronization arrangements, namely, the one in Creemer involving use of a plurality of conduit programs running simultaneously on a host computer system for initiating time multiplexed transfers, and the one in Wu involving the use of a synchronization manager that interacts with interface components associated with respective application programs. It is not clear how these two systems could be combined to produce a workable system, or why one would be motivated to combine them given that each purports to provide a complete solution to the synchronization problem. Moreover, each of these two references teaches away from the claimed arrangements comprising application send files and application read files, by teaching synchronization arrangements which do not involve the use of such files.

The Examiner further argues that one would be motivated to combine or modify Creemer and Wu to meet the claimed invention because "to ensure the system has complete functionality." See the Office Action at page 4, second paragraph, and page 6, last sentence. This is believed to be

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a conclusory statement which fails to meet the above-noted requirements of the <u>In re Sang-Su Lee</u> decision.
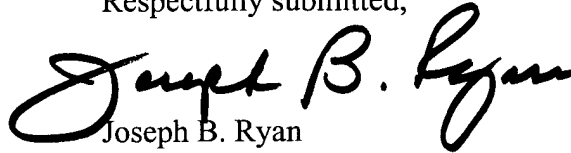
It is therefore believed that a *prima facie* case of obviousness has not been established for independent claims 1, 2, 3 and 7.

Dependent claims 4-6 and 8-10 are believed allowable for at least the reasons identified above with regard to their respective independent claims.

In view of the above, Applicant believes that claims 1-10 are in condition for allowance, and respectfully requests the withdrawal of the § 103(a) rejection.

As indicated previously, a Notice of Appeal is submitted concurrently herewith.

Respectfully submitted,

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Enclosure(s): Notice of Appeal